

## REMARKS

In an Office Action mailed on March 23, 2005, claims 41-68 were rejected under 35 U.S.C. § 112, first paragraph; claims 52, 60 and 67 were rejected under 35 U.S.C. § 112, second paragraph; claims 41, 42, 45, 48, 49 and 51-55, 58-65, 67 and 68 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai and Yoshizawa; claims 43, 56, 57 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai, Yoshizawa and Helm; claim 44 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai, Yoshizawa and Cowell; and claims 46, 47 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai, Yoshizawa and Dresser.

Claims 52, 60 and 67 have been amended to remove the word "examination" to correct typographical errors and overcome the corresponding § 112, second paragraph rejections. The §§ 103 and 112, first paragraph rejections are addressed below.

### § 112, First Paragraph Rejections:

Claims 41-68 stand rejected under 35 U.S.C. § 112, first paragraph because the Examiner contends that the language "automatically determining whether a characteristic of a memory device installed in the computer system other than a size of the memory device limits the capacity of the computer system" allegedly does not appear in the specification. Office Action, 3.

Applicant directs the Examiner's attention to the language beginning on line 22 on page 5 of the specification, language that describes that the memory configuration routine 112 may also account for limitations of a specific memory type that is already in use in the system 100. As an example, this section of the specification describes that the memory configuration routine 112 may consider such factors as the number of devices per memory channel. Thus, this portion of the specification describes at least one way to automatically (via the executing routine 112) determine whether a characteristic of a memory device that is installed in the computer system other than a size of the memory device limits the memory capacity of the computer system. As such, Applicant submits that the specification contains a written description of at least one embodiment of the claim language cited by the Examiner. Thus, for at least this reason, withdrawal of the § 112, first paragraph rejections of claims 41-68 is requested.

§ 103 Rejections of Claims 41-53:

The method of independent claim 41 includes obtaining memory configuration information of a computer system and determining a memory capacity of the computer system. This determination includes automatically determining whether a characteristic of a memory device that is installed in the computer system other than a size of the memory device limits the memory capacity of the computer system. The method includes automatically determining memory upgrade options based on the determined memory capacity of the computer system.

Contrary to the limitations of claim 41, as noted by the Examiner, neither Arai nor Yoshizawa explicitly disclose automatically determining whether a characteristic of a memory device that is installed in the computer system other than a size of the memory device limits the memory capacity of the computer system. To supply the missing limitations, the Examiner relies on alleged inherent features of Arai.

In order for a missing claim limitation to be inherent in a cited reference, however, the missing claim limitation must *necessarily flow* from the reference. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). M.P.E.P. § 2112. Thus, the Examiner fails to establish a *prima facie* case of obviousness for independent claim 41 for at least the reason that the Examiner fails to show why the alleged inherent limitations that are provided by the RAMBUS reference is inherent in Arai. Thus, for at least this reason, a *prima facie* case of obviousness has not been established for claim 41.

Even assuming, for purposes of argument, that the characteristics described in the RAMBUS document are somehow inherent in Arai, the combination of Arai and Yoshizawa still fails to teach or suggest all claim limitations. For example, the Examiner contends that the system, "must determine whether it is there or not (characteristic other than size)." Office Action, 5. However, the determination of this characteristic is precluded by the claim language. In other words, claim 41 recites automatically determining whether a characteristic of a memory device *installed in the computer system* limits the memory capacity of the computer system (*emphasis added*). Thus, claim 41 already sets forth that the memory device is installed in the computer system.

Therefore, for at least the reasons that are set forth above, allowance of claims 41-53 is requested.

§ 103 Rejections of Claims 54-61:

The program storage device of independent claim 54 is readable by a programmable control device and includes instructions for causing the programmable control device to determine a memory capacity for a computer system. This determination includes automatically determining whether a characteristic of a memory device that is installed in the computer system other than a size of the memory device limits the memory capacity of the computer system.

See discussion of independent claim 41 above. In particular, for at least the reason that the hypothetical combination of Arai and Yoshizawa fails to teach or suggest instructions that cause a programmable control device to perform the determination that is set forth in independent claim 54, a *prima facie* case of obviousness has not been set forth for this claim. Although the Examiner relies on inherency, the Examiner fails to make a showing why the RAMBUS disclosure *necessarily flows* from Arai; and thus, for at least this reason, fails to establish a *prima facie* case of obviousness for claim 54.

Thus, allowance of claims 54-61 is requested.

§ 103 Rejections of Claims 62-68:

The computer system of independent claim 62 includes a configuration routine that includes instructions to automatically determine whether a characteristic of a memory device that is installed in the computer system other than a size of the memory device limits the capacity of the computer system.

See discussion of independent claim 41 above. In particular, the Examiner fails to show why portions of the RAMBUS disclosure are inherently present in Arai. Furthermore, even assuming, for purposes of argument, that these features are inherently in Arai, the hypothetical combination of Aria and Yoshizawa still fails to teach or suggest all limitations of independent claim 62. In particular, the Examiner still fails to show how these references allegedly teach or suggest determining a memory capacity by determining a characteristic of a memory device that

is installed in the computer system. As such, for at least this additional, independent reason, a *prima facie* case of obviousness has not been established for claim 62.

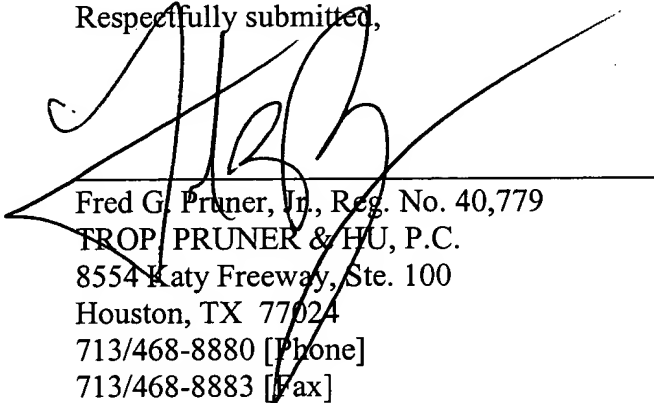
Therefore, for at least the reasons that are set forth above, withdrawal of the § 103 rejections of claims 62-68 is requested.

#### CONCLUSION

In view of the foregoing, withdrawal of the §§ 103 and 112 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees, or credit any overpayment to Deposit Account No. 20-1504 (MCT.0102US).

Respectfully submitted,

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